

## REMARKS

Claims 1-31 are pending in the application. Claims 4, 5, 8, 9 and 18-30 have been withdrawn. No claims have been amended or canceled in this paper.

### Claim Rejections Under 35 U.S.C. § 103

Claims 1, 3, 6, 10, 11, 14 and 15 were rejected under 35 U.S.C. § 103(a) over Murayama et al. (US 2004/0039309 A1) in view of Tezuka (U.S. Patent No. 6,251,085 B1). Claims 2 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Murayama et al. (US 2004/0039309 A1) in view of Tezuka (U.S. Patent No. 6,251,085 B1) as applied to claim 1 in the Office action, and further in view of McMahon (U.S. Patent 6,296,616 B1). Claims 12 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Murayama et al. (US 2004/0039309 A1) and Tezuka (U.S. Patent No. 6,251,085 B1) as applied to claim 1 in the Office action, and further in view of Richardson et al. (WO 01/36034). These rejections are respectfully traversed.

Applicant respectfully asserts that none of the references teaches or suggests “an uninterrupted polymer coating with a generally constant outside diameter” of claim 1, “with a coating profile not following a tapered profile of the elongated core” of claim 16, and “with a coating profile not following a tapered profile of the elongated core” of claim 31.

First, the examiner on page 3 of the final Office action merely makes an unsupported assertion that: “A coating over the catheter would have a generally constant outside diameter.” However, the catheter or its coating cannot be the polymer coating defined in the present claims because the catheter is not “*adhering to and contiguous* with at least a portion of the distal core section” (emphasis added). The catheter would

actually be overlying the polymer coating of the guide wire defined in applicant's claims, and would not meet the noted claim limitations.

Second, if the examiner is referring to the coating/cover layer 7 shown in Fig. 6 of Murayama, or the resin coating 3 shown in Figs. 1-2 of Tezuka, then the prior art still does not teach the claimed invention because the coating according to applicant's claims has "a generally constant outside diameter" or does not follow "a tapered profile of the elongated core." For this reason, not all claim elements are taught or disclosed, so the examiner's *prima facie* obviousness burden has not been met.

Third, since the polymer coatings taught in the cited references do indeed follow the profile of the tapered core, the references teach away from the claimed invention having a constant outside diameter coating profile at the tapered core. It would therefore not be appropriate to modify the references as the examiner urges to arrive at the present invention. MPEP 2145 § X, para. D. The claimed invention is again not obvious in view of the cited references individually or in combination.

Fourth, the proposed modification cannot render the prior art unsatisfactory for its intended purpose. MPEP 2143.01 § V. The intended purpose of the cited references according to the examiner (page 3 Office action) is to "allow for a reduced contact surface area" between the guide wire/coating and the interior of the guiding catheter. However, having a constant outside diameter of the coating would actually increase the total amount of contact surface area with the interior of the catheter. The proposed modification offered by the examiner would render the prior art unsatisfactory for their intended purpose.

Fifth, according to the examiner on page 6 of the Office action, "McMahon discloses a guide wire with a coating of non-uniform thickness not following the tapered profile of the core to create a constant outer diameter." The examiner attempts to modify

the teachings of Murayama and Tezuka with McMahon to arrive at the claimed invention, but applicant respectfully contends that this is improper.

Both Murayama and Tezuka clearly show a coating that follows the surface profile (tapered) and contours (smooth or bumpy) of the core. On the other hand, McMahon in the drawing figures noted by the examiner does not show the surface contour and profile of the coating following the surface contour and profile of the tapered core.

The examiner's stated motivation (page 7 Office action) to modify Murayama and Tezuka with McMahon was "to create a constant outer diameter while still providing for areas of reduced surface contact along the length of the catheter." Tezuka specifically states that the uneven surface of the coating reduces the contact portion and sticking to the catheter (Tezuka, col. 3, lines 19-29). So in Tezuka, the motivation or purpose for reducing the surface contact with the catheter *has already been achieved* by the uneven contour coating of Tezuka that follows the taper of the core. With the examiner's stated purpose of the modification already met, there is no reason left to *further* modify Tezuka with McMahon as the examiner suggests so that the coating profile has a constant OD that does not follow the taper of the core.

The only reason to further modify Murayama and Tezuka with McMahon's constant OD coating was based on applicant's own disclosure (applicant's specification, page 15, lines 3-11) and claim for such structure. This is impermissible use of hindsight MPEP 2143 § X. para. A. Applicant therefore contends that it was improper for the examiner to modify the teachings of Murayama and Tezuka with McMahon. For the reasons given above, the examiner has not established *prima facie* obviousness.

Applicant respectfully disagrees with the examiner's position that the claimed dimensional limitations are obvious and could be derived from routine skill in the art. Applicant respectfully disagrees with the other grounds for rejection not specifically addressed above.

### CONCLUSION

In view of the foregoing, applicant respectfully submits that all claims are now in condition for allowance. Reexamination and reconsideration of the application are respectfully requested and allowance at an early date is solicited. Applicant invites the examiner to telephone the undersigned if there are any remaining questions. It is believed that no additional fee is required for the filing of this response. However, if a fee is in fact due, the Commissioner is authorized to charge any fees or costs to our Deposit Account No. 06-2425.

Respectfully submitted,

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